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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,666	01/28/2005	Peter Scheibli	4-22732/A/PCT	8590

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CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
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EXAMINER	
KHAN, AMINA S	

ART UNIT	PAPER NUMBER
1751	

MAIL DATE	DELIVERY MODE
06/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/522,666	SCHEIBLI, PETER	
	Examiner	Art Unit	
	Amina Khan	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/27/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1 and 4-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Donenfeld (US 4,576,610).

Donenfeld et al. teach applying 27% polyester resin, 10% acrylate binder and 9% glycerin for lubrication to a release paper on which a sublimable dye has been coated

and printing 50:50 polyester:cotton fabrics by applying the free face of the dye bonding composition to the fabric and applying heat to maintain the assembly at about 440°F for 10 minutes (column 9 and 10, examples 1-4).

Donenfeld teaches printing cotton and cotton/polyester blends with compositions comprising water, polyester resins and acrylic dye binders, in a weight ratio such that more than 50% of the combined weight of polyester resin and dye binder is resin, to provide a fabric with a soft hand (column 1, line 60-68; column 2, lines 1,25-30 and 65-68; column 5, lines 27-35; column 7, lines 15-21; column 6, line 32). Donenfeld further teaches that azo disperse dyes are preferred as sublimatable components (column 7, lines 30-35). Donenfeld further teaches applying the dye bonding composition to the fabric and then applying a conventional sublimation dye (column 14, lines 1-10). Donenfeld further teaches applying to a paper based release paper the dye bonding composition and then the dye composition and then a second layer of dye bonding composition (columns 14 and 15, examples 21 and 22).

Regarding the limitations of drying the pretreating solution followed by condensing the polymer, as claimed in claim 6, this would inherently be met by examples 3 and 4 because the bonding layer first impacts the fabric and would be heated causing drying and condensing, followed by the sublimation layer contacting the fabric second.

Accordingly, the teachings of Donenfeld anticipate the material limitations of the instant claims.

In the alternative, if the teachings of Donenfeld are not sufficient to anticipate the material limitations of the instant claims, the claims would be obvious because Donenfeld teaches similar treatment compositions applied to similar substrates by similar methods. One of ordinary skill in the art would expect the teachings of Donenfeld to encompass the instant claim absent unexpected results.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as obvious over Donenfeld (US 4,576,610), as applied to the claims above, and further in view of Fukui et al. (US 5,529,586).

Donenfeld is relied upon as set forth above. Donenfeld clearly teaches preferably using disperse dyes of the azo class which are satisfactorily known to bond polyester (column 7, lines 30-40).

Donenfeld is silent as to the structures of the disperse dyes.

Fukui et al. teach coloring polyester and cotton blends with disperse dyes of Tables 2 and 3 for sublimation transfer coloring (column 9, lines 1-45, columns 3-8). Fukui et al. teach these compositions produce excellent dyeings and printings with high fastness properties.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the printing methods of Donenfeld by incorporating the dyes of Tables 2 and 3 taught by Fukui because Fukui et al. teach the superior sublimation printing produced by these compounds. Furthermore, Donenfeld invites the inclusion of disperse dyes of the azo class which are satisfactorily known to bond

polyester. One of ordinary skill in the art would have been motivated to combine the teaching of the references absent unexpected results.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as obvious over Donenfeld (US 4,576,610), as applied to the claims above, and further in view of Yamane et al. (US 4,210,412).

Donenfeld is relied upon as set forth above.

Donenfeld does not teach crosslinking agents.

Yamane et al., in the analogous art of transfer printing, teach treating cellulosic textiles sublimable dispersible dyes and acrylic binders and additionally treat with crosslinking agents to increase the color fastness to washing of the disperse dye (column 3, lines 20-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the printing methods of Donenfeld by incorporating the crosslinking agents into the second layer of dye bonding agent of example 22 as taught by Yamane because Yamane et al. teach the superior disperse dye color fastness in washing of fabrics treated with the crosslinker. One of ordinary skill in the art would have been motivated to combine the teachings of the references absent unexpected results.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,284,004 in view of Donenfeld (US 4,576,610). While claim 1 of the '004 patent does not recite polyester resins and acrylate binders and cellulosic fabrics treating these fabrics and incorporating these resins would be obvious since patent '610 clearly teaches printing cotton and cotton/polyester blends with compositions comprising water, polyester resins acrylic dye binders and azo disperse dyes are preferred as dye components (column 7, lines 30-35). One of ordinary skill in the art would have been motivated to combine the teachings of the references absent unexpected results.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amina Khan whose telephone number is (571) 272-5573. The examiner can normally be reached on Monday through Friday, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AK
June 18, 2007

LORNA M. DOUYON
PRIMARY EXAMINER